

PATENT
Attorney Docket No.: SALK3130-1J
(088802-9705)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Downes et al.

Application No.: 10/535,041

Filing Date: May 13, 2005

For: NON-STEROIDAL FARNESOID X
RECEPTOR MODULATORS

Group Art Unit: 1645

Examiner: Unknown

CERTIFICATE OF FACSIMILE TRANSMISSION
I hereby certify that this paper is being facsimile transmitted to the
United States Patent and Trademark Office, Washington, D.C., on
the date below.

Stephen E. Reiter

Printed Name

Signature Date 12/28/05

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DEC 28 2005

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Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

13 FEB 2006

Legal Staff
International Division

DECLARATION OF FACTS IN SUPPORT OF PETITION UNDER 37 C.F.R. § 1.47

I, Sheila R. Kirschenbaum, declare that:

1. I, Sheila R. Kirschenbaum, am Patent Counsel to Applicant, the Salk Institute for Biological Studies, located in La Jolla, CA.
2. Inventors Michael Downes and Ronald Evans were employed by the Salk Institute for Biological Studies at the time of conception of the invention.
3. Inventors Robert Hughes, K.C. Nicolaou and Anthony J. Roecker were employed by The Scripps Research Institute located in La Jolla, CA at the time of conception of the invention.
4. Thomas Fitting, Esq., Ph.D. is Chief Patent Counsel to The Scripps Research Institute, and is the legal representative of Messrs. Hughes, Nicolaou and Roecker with respect to patent matters.

In re Application of: Downes et al.
Application No.: 10/535,041
Filing Date: May 13, 2005
Page 2

PATENT
Attorney Docket No.: SALK3130-1J
(088802-9705)

5. A Declaration by Inventor for signature by Messrs. Hughes, Nicolaou and Roecker in United States Application No. 10/535,041 along with copies of the application were sent to Dr. Fitting, Esq. via Federal Express courier service on August 12, 2005. Dr. Fitting, as legal representative of Messrs. Hughes, Nicolaou and Roecker, was informed in an accompanying letter (Exhibit A) of the requirement that each inventor named on United States Application No. 10/535,041, including Messrs. Hughes, Nicolaou and Roecker, execute a Declaration by Inventor.
6. No Declaration by Inventor in United States Application No. 10/535,041, signed by Messrs. Hughes Nicolaou or Roecker was received in response to the request described in point 5.
7. Dr. Fitting, Esq., in a telephone conversation on October 26, 2005, acknowledged receipt of my letter dated August 12, 2005 requesting signatures on a Declaration by Inventors. Dr. Fitting, Esq. informed me that the matter including the Declaration by Inventor was being "reviewed by the tech transfer office".
8. Ms. Jennifer Dyer, Director of Technology Development at The Scripps Research Institute, in a telephone conversation on December 5, 2005 informed me that Scripps inventors would not be signing the Declaration by Inventor.
9. I informed Dr. Fitting, Esq. of my telephone conversation with Ms. Dyer by letter (Exhibit B), sent via facsimile and e-mail on December 7, 2005,.
10. Dr. Fitting, Esq., in a telephone conversation on December 14, 2005, acknowledged receipt of my letter of December 7, 2005. Dr. Fitting, Esq. again stated that none of the Scripps inventors would be signing the Declaration by Inventor.

DEC. 28. 2005 5:21PM

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In re Application of: Downes et al.
Application No.: 10/535,041
Filing Date: May 13, 2005
Page 3

PATENT
Attorney Docket No.: SALK3130-1J
(088802-9705)

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date 27 December 2005

Sheila R. Kirschenbaum
Sheila R. Kirschenbaum
Patent Counsel,
The Salk Institute

Atty. Dkt. No. SALK 3130-1J
(088802-9705)

DECLARATION AND POWER OF ATTORNEY

As a below named inventor, I HEREBY DECLARE:

THAT my residence, post office address, and citizenship are as stated below next to my name;

THAT I believe I am the original, first, and sole inventor (if only one inventor is named below) or an original, first, and joint inventor (if plural inventors are named below or in an attached Declaration) of the subject matter which is claimed and for which a patent is sought on the invention entitled

NON-STEROIDAL FARNESOID X RECEPTOR MODULATORS

Attorney Docket No. SALK 3130-1J (088802-9705)

the specification of which (check one)

 is attached hereto.

 X was filed on 05/13/2005 as United States Application Number 10/535,041 based on PCT International Application Number PCT/US2003/036123 filed on 11/14/2003 and was amended on 5/13/2005 (if applicable).

THAT I do not know and do not believe that the same invention was ever known or used by others in the United States of America, or was patented or described in any printed publication in any country, before I (we) invented it;

THAT I do not know and do not believe that the same invention was patented or described in any printed publication in any country, or in public use or on sale in the United States of America, for more than one year prior to the filing date of this United States application;

THAT I do not know and do not believe that the same invention was first patented or made the subject of an inventor's certificate that issued in any country foreign to the United States of America before the filing date of this United States application if the foreign application was filed by me (us), or by my (our) legal representatives or assigns, more than twelve months (six months for design patents) prior to the filing date of this United States application;

THAT I have reviewed and understand the contents of the above-identified specification, including the claim(s), as amended by any amendment specifically referred to above;

THAT I believe that the above-identified specification contains a written description of the invention, and of the manner and process of making and using it, in such full, clear,

Atty. Dkt. No. SALK 3130-1J
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concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention, and sets forth the best mode contemplated by me of carrying out the invention; and

THAT I acknowledge the duty to disclose to the U.S. Patent and Trademark Office all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, §1.56.

I HEREBY CLAIM foreign priority benefits under Title 35, United States Code §119(a)-(d) or § 365(b) of any foreign application(s) for patent or inventor's certificate, or §365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below any foreign application for patent or inventor's certificate or of any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application Number	Country	Foreign Filing Date	Priority Claimed?	Certified Copy Attached?

I HEREBY CLAIM the benefit under Title 35, United States Code § 119(e) of any United States provisional application(s) listed below.

U.S. Provisional Application Number	Filing Date
60/426664	11/15/2002

I HEREBY CLAIM the benefit under Title 35, United States Code, §120 of any United States application(s), or § 365(c) of any PCT international application designating the United States of America, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of Title 35, United States Code, § 112, I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

U.S. Parent Application Number	PCT Parent Application Number	Parent Filing Date	Parent Patent Number
10/658115		9/8/2003	

Atty. Dkt. No. SALK 3130-1J
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I HEREBY APPOINT the registered attorneys and agents at Customer Number

30542

to have full power to prosecute this application and any continuations, divisions, reissues, and reexaminations thereof, to receive the patent, and to transact all business in the United States Patent and Trademark Office connected therewith.

I request that all correspondence be directed to:

Stephen E. Reiter
FOLEY & LARDNER LLP
Customer Number: 30542

Telephone: (858) 847-6711
Facsimile: (858) 792-6773

I UNDERSTAND AND AGREE THAT the foregoing attorneys and agents appointed by me to prosecute this application do not personally represent me or my legal interests, but instead represent the interests of the legal owner(s) of the invention described in this application.

I FURTHER DECLARE THAT all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Name of first inventor	<u>Michael R. Downes</u>
Residence	<u>San Diego, California CA</u>
Citizenship	<u>Australia</u>
Post Office Address	<u>3440 Lebon Drive, Apt. 4210 2730 HAVASUDA AVE m Q</u> <u>San Diego, California 92122 92117</u>
Inventor's signature	<u>m. Downes</u>
Date	<u>8/17/05</u>

Atty. Dkt. No. SALK 3130-1J
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Name of second inventor

Ronald M. Evans

Residence

La Jolla, California

Citizenship

United States of America

Post Office Address

1471 Cottontail Lane
La Jolla, California 92037

Inventor's signature

Date

3 - 00

Name of third inventor

Robert Hughes

Residence

Creve Couer, Missouri MO

Citizenship

Great Britain

Post Office Address

800 N. Lindberg, Q403
Creve Couer, Missouri 63167

Inventor's signature

Date

4 - 00

Name of fifth inventor

Kyriacos C Nicolaou

Residence

La Jolla, California CA

Citizenship

United States of America

Post Office Address

9625 Blackgold Road
La Jolla, California 92037

Inventor's signature

Date

5 - 00

Name of fourth inventor

Anthony J Roecker

Residence

San Diego, California CA

Citizenship

United States of America

Post Office Address

3337 Clairemont Drive, #4
San Diego, California 92117

Inventor's signature

Date

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Stephen E. Reiter
FOLEY & LARDNER LLP
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Telephone: (858) 847-6711
Facsimile: (858) 792-6773

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Name of first inventor	Michael R. Downes
Residence	San Diego, California
Citizenship	Australia
Post Office Address	3440 Lebon Drive, Apt. 4210 San Diego, California 92122
Inventor's signature	
Date	

Atty. Dkt. No. SALK 3130-1J
(088802-9705)

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Name of second inventor	<u>Ronald M. Evans</u>
Residence	<u>La Jolla, California CA</u>
Citizenship	<u>United States of America</u>
Post Office Address	<u>1471 Cottontail Lane</u> <u>La Jolla, California 92037</u>
Inventor's signature	<u>Ronald M. Evans</u>
Date	<u>8/17/05</u>
Name of third inventor	<u>Robert Hughes</u>
Residence	<u>Creve Couer, Missouri</u>
Citizenship	<u>Great Britain</u>
Post Office Address	<u>800 N. Lindberg, Q403</u> <u>Creve Couer, Missouri 63167</u>
Inventor's signature	
Date	
Name of fifth inventor	<u>Kyriacos C Nicolaou</u>
Residence	<u>La Jolla, California</u>
Citizenship	<u>United States of America</u>
Post Office Address	<u>9625 Blackgold Road</u> <u>La Jolla, California 92037</u>
Inventor's signature	
Date	
Name of fourth inventor	<u>Anthony J Roecker</u>
Residence	<u>San Diego, California</u>
Citizenship	<u>United States of America</u>
Post Office Address	<u>3337 Clairemont Drive, #4</u> <u>San Diego, California 92117</u>
Inventor's signature	
Date	

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